

**REMARKS**

Upon entry of the present amendment, claims 1-2, 4-5, 8-9 and 11-12 will remain pending in the above-identified application and stand ready for further action on the merits. Claim 1 has been amended and claims 3 and 10 have been cancelled.

The present amendments to the claims do not introduce new matter into the application as originally filed. For example, support for the instant amendment to claim 1 occurs in the application as originally filed, including original claims 3 and 10, which are each herein canceled.

Accordingly, entry of the instant amendment and favorable action on the merits is earnestly solicited at present.

**Claim Rejections -- 35 USC § 112**

Claim 10 has been rejected under the provisions of 35 USC §112, second paragraph. Reconsideration and withdraw of this rejection is respectfully requested at present, based on the cancellation of claim 10.

Further, it is submitted that each of remaining pending claims 1-2, 4-5, 8-9 and 11-12 fully comply with the provisions of 35 USC §112, second paragraph, as they particularly and distinctly set forth the inventive discovery that the applicants regard as their own. As stated in M.P.E.P. §§ 2173.01 and 2173.02 :

*A fundamental principle contained in 35 U.S.C. 112, second paragraph is that applicants are their own lexicographers. They can define in the claims what they regard as their invention essentially in whatever terms they choose so long as any special meaning assigned to a term is clearly set forth in the specification. See MPEP § 2111.01. Applicant may use functional language, alternative expressions, negative limitations, or any style of expression or format of claim*

*which makes clear the boundaries of the subject matter for which protection is sought. As noted by the court in In re Swinehart, 439 F.2d 210, 160 USPQ 226 (CCPA 1971), a claim may not be rejected solely because of the type of language used to define the subject matter for which patent protection is sought.*

*The examiner's focus during examination of claims for compliance with the requirement for definiteness of 35 U.S.C. 112, second paragraph, is whether the claim meets the threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available. When the examiner is satisfied that patentable subject matter is disclosed, and it is apparent to the examiner that the claims are directed to such patentable subject matter, he or she should allow claims which define the patentable subject matter with a reasonable degree of particularity and distinctness. Some latitude in the manner of expression and the aptness of terms should be permitted even though the claim language is not as precise as the examiner might desire. Examiners are encouraged to suggest claim language to applicants to improve the clarity or precision of the language used, but should not reject claims or insist on their own preferences if other modes of expression selected by applicants satisfy the statutory requirement.*

#### ***Claim Rejections -- 35 USC 102 & 103(a)***

In the outstanding office action, the Examiner has set forth the following nine (9) distinct prior art rejections.

Claims 1-2 and 8-11 have been rejected under the provisions of 35 USC § 102(e) as being anticipated by **Doshi US '833** (US 2005/0272833) taken in view of **Patil et al. US '333** (US 5,907,333) and *Hawley's Condensed Chemical Dictionary*.

Claims 1-2 and 8-11 have been rejected under the provisions of 35 USC § 102(b) as being anticipated by **Ichikawa US '624** taken in view of *Hawley's Condensed Chemical Dictionary*.

Claims 1-2, 5 and 8-9 have been rejected under the provisions of 35 USC § 102(e) as being anticipated by **Kiguchi et al. US '364** (US 6,627,364).

Claims 3-4 have been rejected under the provisions of 35 USC § 103(a) as being rendered obvious by Ichikawa US '624 taken in view of Suzuki et al. US '832 (US 6,245,832).

Claims 3-4 have been rejected under the provisions of 35 USC § 103(a) as being rendered obvious by Kiguchi et al. US '364 taken in view of Suzuki et al. US '832 (US 6,245,832).

Claims 1-3 and 8-12 have been rejected under the provisions of 35 USC § 103(a) as being rendered obvious by WO '619 (WO 02/556619) in view of Zhu et al. US '175 (US 6,251,175) and Ohta et al. US '866 (US 5,954,866).

Claim 4 has been rejected under the provisions of 35 USC § 103(a) as being rendered obvious by WO '619 in view of Zhu et al. US '175 and Ohta et al. US '866, further in view of Suzuki et al. US '832.

Claims 1-3 and 8-9 and 12 have been rejected under the provisions of 35 USC § 103(a) as being rendered obvious by JP '431 (JP 07-109431) in view of Zhu et al. US '175 and Ohta et al. US '866.

Claim 4 has been rejected under the provisions of 35 USC § 103(a) as being rendered obvious by JP '431 in view of Zhu et al. US '175 and Ohta et al. US '866, further in view of Suzuki et al. US '832.

*Legal Standard for Determining Anticipation*

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v.*

*Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). “When a claim covers several structures or compositions, either generically or as alternatives, the claim is deemed anticipated if any of the structures or compositions within the scope of the claim is known in the prior art.” *Brown v. 3M*, 265 F.3d 1349, 1351, 60 USPQ2d 1375, 1376 (Fed. Cir. 2001) “The identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipse dixit* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

*Legal Standard for Determining Prima Facie Obviousness*

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Paeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

“There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary

skill in the art.” *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) (The combination of the references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a *prima facie* case of obvious was held improper.).

“In determining the propriety of the Patent Office case for obviousness in the first instance, it is necessary to ascertain whether or not the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the reference before him to make the proposed substitution, combination, or other modification.” *In re Linter*, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. “The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art.” *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also *In re Lee*, 277 F.3d 1338, 1342-44, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002) (discussing the importance of relying on objective evidence and making specific factual findings with respect to the motivation to combine references); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

The Supreme Court of the United States has recently held that the teaching, suggestion, motivation test is a valid test for obviousness, but one which cannot be too rigidly applied. See

*KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. \_\_\_\_\_, 82 USPQ2d 1385 (U.S. 2007). The Supreme Court in *KSR Int'l Co. v. Teleflex, Inc.*, *ibid.*, reaffirmed the Graham factors in the determination of obviousness under 35 U.S.C. § 103(a). The four factual inquiries under Graham are:

- (a) determining the scope and contents of the prior art;
- (b) ascertaining the differences between the prior art and the claims in issue;
- (c) resolving the level of ordinary skill in the pertinent art; and
- (d) evaluating evidence of secondary consideration.

*Graham v. John Deere*, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (U.S. 1966).

The Court in *KSR Int'l Co. v. Teleflex, Inc.*, *supra.*, did not totally reject the use of "teaching, suggestion, or motivation" as a factor in the obviousness analysis. Rather, the Court recognized that a showing of "teaching, suggestion, or motivation" to combine the prior art to meet the claimed subject matter could provide a helpful insight in determining whether the claimed subject matter is obvious under 35 U.S.C. § 103(a).

Even so, the Court in *KSR Int'l Co. v. Teleflex, Inc.*, *ibid.*, rejected a rigid application of the "teaching, suggestion, or motivation" (TSM) test, which required a showing of some teaching, suggestion, or motivation in the prior art that would lead one of ordinary skill in the art to combine the prior art elements in the manner claimed in the application or patent before holding the claimed subject matter to be obvious.

#### *Distinctions Over the Cited Art*

Although Doshi US '833 discloses solvents which may cover the solvents used according to the present invention (*see* Paragraph [0335]), Doshi US '833 does not describe or teach an acid value of a resin.

WO '619, JP '431 and Ichikawa US '624 disclose some solvents which may be relevant to the present invention. However, none of these cited art references suggest the antigrazing properties of printed materials with ink compositions.

Suzuki et al. US '832, Zhu et al. US '175 and Ohta et al. US '866 disclose the acid value of resins. However, none of them describe or teach other characteristic features of the present invention such as the kind and boiling point of the solvent and the acid value of the resin.

The effects of the present invention can be achieved, only when an ink composition meets all the requirements of claim 1, that is,

- 1) an organic solvent having a boiling point of at least 150°C;
- 2) a resin having an acidic group being a water-insoluble acrylic resin having a hydrophobic group and an acid value of 10 to 300 mg-KOH/g;
- 3) the organic solvent being one selected from the group consisting of a monoalkyl ether monoalkyl ester derivative of (poly)alkylene glycol and a dialkyl ester derivative of (poly)alkylene glycol.

If one of these characteristics is missing from an ink composition, the effects of the present invention are not achieved.

**In support of the above contention, the instant Inventors submit the enclosed Rule 132 Declaration of Mr. Takuo Mizutani, which is attached hereto.**

The Examiner is respectfully requested to consider Mr. Mizutani's enclosed declaration at this time, since the same contains comparative testing and comparative testing results therein that are material to a consideration of the patentability of the instant invention.

CONCLUSION


Based upon the amendments and remarks presented herein, the Examiner is respectfully requested to issue a Notice of Allowance clearly indicating that each of pending claims 1-2, 4-5, 8-9 and 11-12 are allowed and patentable under the provisions of Title 35 of the United States Code.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact John W. Bailey (Reg. No. 32,881) at the telephone number below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

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Respectfully submitted,

By 

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Enclosure: Rule 132 Declaration of Mr. Takuo Mizutani